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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY L. KRAMER

Appeal No. 1998-2051
Application 08/426,814

HEARD: APRIL 19, 2000

Before CALVERT, PATE and HANLON, Administrative Patent Judges.
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 20 and 21. These are the only claims remaining in the application.

The claimed invention is directed to an over-the-guidewire catheter. The novel feature of the catheter is a

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slit in the catheter wall by which the catheter can be peeled over a guidewire that remains in place in a patient's vasculature.

A further understanding of the claimed invention can be garnered by referring to the appealed claims appended to appellant's brief.

The U.S. Patent forming the basis of the examiner's double patenting rejection is:

Kramer	5,135,535	August 4, 1992
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The reference relied upon by the examiner as evidence of anticipation with respect to claim 21 is:

Neracher	5,135,482	August 4, 1992
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THE REJECTIONS

Claim 20 stands rejected under the judicially created doctrine of double patenting over claim 1 of U.S. Patent No. 5,135,535. The examiner states that claim 20, if allowed, would improperly extend "the right to exclude" already granted in the patent.

Claim 21 stands rejected under 35 U.S.C. § 102(e) as anticipated by Neracher. According to the examiner, Neracher discloses an adapter for mounting on the proximal end of an

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intravascular catheter. The catheter has an inner inflation lumen 19 and an inner guidewire receiving lumen 18. The examiner refers to port 20 as a means in the wall of the adapter body

which permits the guidewire to exit laterally from the adapter body.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review we have reached the determination that claim 20 presents an impermissible timewise extension of the right to exclude with respect to appellant's prior patent. Accordingly, the rejection of claim 20 is affirmed. With respect to the rejection of claim 21, it is our determination that Neracher does not anticipate this claim. Therefore the rejection of claim 21 is reversed. Our reasons follow.

Turning to a consideration of the rejection of claim 20, appellant argues that the examiner's rejection is "a non-obviousness-type double patenting rejection." The appellant argues that such a rejection is improper and should be

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withdrawn. We disagree with the position of the appellant on two separate grounds. First of all, the examiner's statement of the rejection does not refer to a non-obviousness-type double patenting rejection. While the examiner does refer to In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) in his remarks, the examiner certainly does not refer to this ground in the statement of the rejection. Having analyzed claim 20 with respect to claim 1 in appellant's prior patent, it is our conclusion that a double patenting rejection of the obviousness-type is proper in this instance. The generic invention of claim 20 is anticipated by the species of the patented invention. Cf. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985), (holding that an earlier species disclosure in the prior art defeats any generic claim). The Federal Circuit's predecessor court has held that without a terminal disclaimer, the species claims preclude issuance of the generic invention. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767. See In re Goodman, 11 F.3d 1046, 1053, 29 USPQ2d 2010, 2016 (Fed. Cir. 1993)("without a terminal disclaimer, the species claim precludes issuance of the generic application"). Accord, Eli

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Lilly & Co. v. Barr Labs., Inc., ____ F.3d ____, 55 USPQ2d 1609, 1619 (Fed. Cir 2000).

Secondly, appellant includes an argument that amounts to the argument that In re Schneller is no longer "good" law. In re Schneller, 397 F.2d 350, 355, 158 USPQ 210, 215 (CCPA 1968), dealt with a special fact situation of obviousness-type double patenting which is relevant to the instant appeal. The PTO had applied the term "non-'obviousness-type'" (as opposed to "obviousness-type") double patenting to the factual situation in Schneller in the past, MPEP § 804 (6th edition. Jan. 1995), pages 800-15, 16, but does not now use this label, MPEP § 804 (7th ed. Jul. 1998), pages 800-21 through 800-23. In our view Schneller is simply an obviousness-type double patenting case with special facts. The examiner's Schneller-type double patenting rejection is thus properly considered as part of the obviousness-type double patenting analysis.

Although appellant cites obviousness-type double patenting cases later than Schneller such as In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 621-22 (CCPA 1970), to stand for the proposition that Schneller-type double patenting is no

longer a viable doctrine, appellant fails to cite such cases as In re Van Ornum, 686 F.2d at 944, 214 USPQ at 767, which treat the Schneller decision with approval. The non-obviousness type double patenting language that seems to be a problem for appellant, probably arose in Schneller at 353-54, 158 USPQ at 214:

This is not a case of an improvement or modification invented after filing. Hence it is not the usual "obviousness-type" double patenting case. Neither is it a "same invention type" double patenting case . . .

This may be where the PTO got the terminology "non-obviousness-type double patenting." However, the court in Schneller emphasized that Schneller was simply a case where there was no justification for the timewise extension of the right to exclude past the expiration date of the previously granted patent. Such an impermissible extension would prevail in the instant case were we not to affirm the examiner's rejection.

With respect to claim 21 we note the limitation therein: "the wall being adapted to form a slit from said proximal opening to said distal opening to allow a guidewire to exit laterally from the inner guidewire receiving lumen through the

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slit in the adapted wall." When questioned at oral hearing, appellant's attorney stated that "being adapted" meant that the wall of the catheter is *modified in some manner to form a slit*. With this definition in mind, it is our finding that Neracher does not have a wall that is modified in some manner to form a slit. Neracher merely shows a port 20 in the side of the adapter. A single port cannot be considered a slit. Furthermore, as to the examiner's theory that the "adapted to" language is so broad that a reference showing no modification at all of the catheter wall, and which could be cut with a tool to form a slit, can be considered as "adapted to form a slit", this theory is merely an admission that Neracher does not have such a slit forming structure and does not anticipate appellants claimed subject matter. Appellant's claimed subject matter including a wall being adapted to form a slit, which we have construed as a wall modified in some manner to form a slit, while broad, is not so broad as to read on a wall showing no modification at all. The rejection of claim 21 is reversed.

No time period for taking any subsequent action in

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connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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WILLIAM F. PATE, III)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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